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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,582	11/13/2003	Wayne Franklin Chip Burton JR.	1074-043 (PB10059.00)	1700
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Jason D. Kelly Shumaker & Sieffert, P.A. 1625 Radio Drive Suite 300 St. Paul, MN 55125			EXAMINER	
RANGREU, SHEETAL				
ART UNIT		PAPER NUMBER		
3686				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,582

Applicant(s)

CHIP BURTON ET AL.

Examiner

SHEETAL R. RANGREJ

Art Unit

3686

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Prosecution History Summary

- Claims 12-13 are cancelled.
- Claims 1-5, 9-10, and 15-16 have been amended.
- Claim 17 is new.
- Claims 1-11 and 14-17 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-11 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haller et al. (U.S. Publication No. 2002/0013613).

1. As per claim 1, Haller teaches a method of compensating an operator of a defibrillator for expenses incurred as a result of use of the defibrillator for the benefit of another party to whom the operator has no duty to provide use of the defibrillator, the method comprising the steps of:
-receiving a pre-determined monetary amount as a premium from the operator (**Haller: para. 0178**);
-maintaining a contractual relationship with the operator for a period of time in exchange for the

pre-determined monetary amount (**Haller: para. 0191**) the contractual relationship including a requirement to reimburse the operator for at least a portion of the expenses incurred as a result of using the defibrillator for the benefit of the other party (**Haller: para. 0178; para. 0188**); -determining, with a computing system, that the external defibrillator was used for the benefit of the other party during the period of time (**Haller: para. 0098; 0155-0156; 0171**); and -in response to the determination, reimbursing the operator, in accordance with the contractual relationship and with the computing system, for the at least a portion of the expenses incurred by the operator as a result of the defibrillator being used for the benefit of the other party (**Haller: para. 0188-0189**).

Applicant has amended claim 1, by adding the limitations external defibrillator and wherein the contractual relationship includes a requirement to reimburse the operator. As per this element, Haller does not explicitly teach wherein the contractual relationship includes a requirement to reimburse the operator. The limitation of the contractual relationship including a requirement to reimburse is a non-functional descriptive material. A clause within a contract could include a reimbursement clause, but the clause itself is a non-functional descriptive material. The invention is drawn to a contract including a clause to reimburse the operator. Any health related contract is representative of containing clauses related to reimbursement.

The reference fails to teach the method directed for an external defibrillator. However, the difference between the reference (prior art) and claims 12, 15, and 16 relates only to the intended use of the invention (i.e., to the types of defibrillator). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and

the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitation.

Haller does not explicitly teach a method of insuring costs associated with an external defibrillator. However, Haller discloses a method of insuring costs that can be applied to a variety of products/goods, regardless of the intended field of use of the method. Haller teaches a method of insuring costs associated with an internal defibrillator, though the method/system has utility in other applications. The method/system being adapted to an external defibrillator is irrelevant since the intended use does not change the overall functionality of the method. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to use the Haller method towards an external defibrillator because the Haller system is designed to be used towards any product/goods regardless of the intended use.

Examiner takes Official Notice that using an external defibrillators in response to another party undergoing a medical emergency is an old and well known usage in the healthcare art. It would have been obvious at the time of the invention to one of ordinary skill in the art to use the defibrillator of Haller for a purpose of assisting another party undergoing a medical emergency.

2. As per claim 2, the method of claim 1 is as described. Haller further teaches wherein the maintaining step comprises maintaining contractual relationships with a plurality of operators (Haller: para. 0191).

3. As per claim 3, the method of claim 2 is as described. Haller further teaches further comprising allocating the expenses across the plurality of operators (**Haller: para. 0189**). The examiner interprets that allocation of expenses were done due to reimbursements.
4. As per claim 4, the method of claim 1 is as described. Haller further teaches wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount from the operator upon purchase of the defibrillator by the operator (**Haller: para. 0178; para. 0185**).
5. As per claim 5, the method of claim 4 is as described. Haller further teaches wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary amount from the operator at a regular interval corresponding to the period of time (**Haller: para. 0178; para. 0188-0189**).
6. As per claim 6, the method of claim 5 is as described. Haller further teaches wherein the regular interval further corresponds to a period of contract for maintenance of the defibrillator (**Haller: para. 0189**).
7. As per claim 7, the method of claim 5 is as described. Haller further teaches wherein the period of time is annually (**Haller: para. 0191**).
8. As per claim 8, the method of claim 5 is as described. Haller further teaches wherein the period of time is monthly (**Haller: para. 0191**).
9. As per claim 9, the method of claim 4 is as described. Haller further teaches wherein receiving the pre-determined monetary amount comprises receiving the pre-determined monetary

amount from the operator in conjunction with receipt of a lease payment for the defibrillator (**Haller: para. 0191**).

10. As per claim 10, the method of claim 1 is as described. Haller further teaches further comprising the step of requesting compensation for the reimbursement from the other party (**Haller: para. 0188-0189**).

11. As per claim 11, the method of claim 1 is as described. Haller further teaches wherein the period of time continues in perpetuity (**Haller: para. 0191**).

12. As per claim 14, the method of claim 12 is as described. Haller further teaches further comprising the step of seeking compensation for the reimbursement from an insurance carrier associated with the other party (**Haller: para. 0178; para. 0188**).

13. System claim 15 repeat the subject matter of claim 1 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 1, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and incorporated herein.

14. System claim 16 repeat the subject matter of claim 12 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 12, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these

limitations are rejected for the same reasons provided in the rejection of claim 12 and incorporated herein.

15. As per claim 17, the method of claim 1 is as described. Haller further teaches wherein the expense incurred as a result of the external defibrillator being used to benefit the other party include at least one of restoring the external defibrillator, refurbishing the external defibrillator, or replacing the external defibrillator with a different external defibrillator (**Haller: para. 0193**).

Response to Arguments

16. Applicant's arguments filed for claims 1-16 have been fully considered but they are not persuasive.

17. Applicant argues that Examiner ignores the limitation of claim 1 reciting contractual relationship is in exchange for the received pre-determined monetary amount. Applicant further argues that Haller does not suggest that the prepaid card of paragraph 178 may be used to make the rental or lease payments of paragraph 191, or payments in exchange for any contractual relationship. Examiner disagrees with the Applicant. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that Haller teaches that pre-paid cards could be employed with their billing and invoicing systems (i.e. contractual relationship with an insurance provider), which maintains a contractual relationship with the operator for however long the patient needs the defibrillator.

18. Haller teaches government reimbursements for service charges incurred for using the defibrillator (i.e. a requirement to reimburse the operator for at least a portion of the expenses

incurred by the operator as a result of the defibrillator being used for the benefit of the other party). Haller does not expressly teach the specific data recited as in the contractual relationship including a reimbursement clause as in claims 1, 15, and 16; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* 2106. Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter. USPTO personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping or sequence of musical notes read from memory and thereafter causes another defined series of notes to be played, requires a functional interrelationship among

that data and the computing processes performed when utilizing that data. Claim 1 recites a mere arrangement or compilation of facts or data (i.e. contractual relationship); a contract is a mere compilation of data.

19. Applicant argues that Haller teaches receiving reimbursement operation prior to provision of a therapy or other remedial action rather than reimbursing in response to a determination that a defibrillator was used. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that Haller teaches a reimbursement of the services rendered, as claimed.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. R. R./
Examiner, Art Unit 3686
March 18, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686